



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,252	04/05/2001	J. Charles Taylor	39292/256238	5171

30559 7590 09/03/2003

CHIEF PATENT COUNSEL
SMITH & NEPHEW, INC.
1450 BROOKS ROAD
MEMPHIS, TN 38116

EXAMINER

HO, UYEN T

ART UNIT	PAPER NUMBER
----------	--------------

3731

DATE MAILED: 09/03/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

N, K

Office Action Summary

Application No.

09/827,252

Applicant(s)

TAYLOR ET AL.

Examiner

(Jackie) Tan-Uyen T. Ho

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) 15-18, 20, 21, 23, 27 and 29-31 is/are rejected.
- 7) ☒ Claim(s) 22, 24-26, 28 and 32-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 December 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3731

DETAILED ACTION

Election/Restrictions

1. Applicant's election of I in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

2. The information disclosure statement filed 12/31/2002 has been considered and placed in the application file.

Claim Objections

3. Claims 23 and 31 are objected to because of the following informalities: "is positioned on a patient" should be "is adapted to be position on a patient". Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3731

5. Claims 15-8, 20, 21, 23, 27, 29, 30 and 31 rejected under 35 U.S.C. 102(b) as being anticipated by A.S.A.M.I. Group (Operative Principles of Ilizarov).

In regard to claims 15-18, A.S.A.M.I. Group discloses a fixation system including a plurality of circular fixation plates (Fig. 2.14) comprising at least six points, such that a first fixation plate can be rotated less than 60 degree about a central axis and the points of the first fixation plate will maintain a defined relationship with respect to the points of another fixation plate in the system. A.S.A.M.I. also disclose a full ring/plate comprises a plurality of points in a number that is a multiple of six, providing 2x3 symmetry (2, Fig. 2.1)

In regard to claim 20, wherein the points on the plates are positioned so that in use points on opposite plates move into alignment as adjustment is effected (Fig. 2.14)

In regard to claim 21, wherein the points are attachment structures (Fig. 2.14)

In regard to claim 23, wherein the system is adapted to be placed on a patient.

In regard to claim 27, wherein the at least six points are provided in number that is a multiple of three.

In regard to claims 29-31, A.S.A.M.I Group discloses a fixation system including at least two of circular fixation plates (Fig. 2.14) comprising at least six points, such that a first fixation plate can be rotated less than 60 degree about a central axis and the points of the first fixation plate will maintain a defined relationship with respect to the points of another fixation plate in the system, and a plurality of struts (a, Fig. 2.13) adapted to interconnect the plates at various positions, wherein the points facilitate

Art Unit: 3731

attachment of the struts and an accessory adapted to be attached to either or both of the at least two fixation plates.

Note: The introductory statement of intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over the device as disclosed by A.S.A.M.I. which is capable of being used as claimed if one desires to do so.

Allowable Subject Matter

6. Claims 1-14 are allowed. Claims 22, 24-26, 28, 32-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: In regard to claim 1-14 and 22 the prior art fails to disclose or suggest the attachment structures being positioned in the system as claimed. In regard to claims 24-26, 28 and 32-34, the prior art fails to disclose or suggest the system including six struts being connected to the points as claimed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is (703) 306-3421. The examiner can normally be reached on MULTIFLEX Mon. to Sat..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

Art Unit: 3731

746-3977 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

JH
August 13, 2003



MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700